



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,096	10/05/2006	Kym John Keightley		1708

58478

7590

01/28/2010

BIO INTELLECTUAL PROPERTY SERVICES (BIO IPS) LLC

8509 KERNON CT.

LORTON, VA 22079

EXAMINER

HOWELL, DANIEL W

ART UNIT

PAPER NUMBER

3726

MAIL DATE

DELIVERY MODE

01/28/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,096

Applicant(s)

KEIGHTLEY, KYM JOHN

Examiner

Daniel W. Howell

Art Unit

3726

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 and 27 is/are allowed.
- 6) ☒ Claim(s) 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 16-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Cantlon (7104738). It is noted that Cantlon has a provisional application filed on June 27, 2003, and this provisional application is available to the public on PAIR. The subject matter in this rejection is disclosed in that provisional application. Boss 26 has a larger diameter thread 54 and a smaller diameter thread 52, both of which secure hole saws. Hole saws of varying diameter are illustrated. Annular groove 56 is a notch. Base 53, 55, is located in a mandrel 22. The threads are considered to be long enough that more than one hole saw can be placed on the threaded portion. Note drill bit 28.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 16, 18, 19, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webster (2917975) in view of Mori (4325664). Webster shows a boss/base member 1 has a first threaded member 4 of a relatively large diameter and a second threaded member 6 of a relatively smaller diameter. The device is capable of supporting a threaded hole saw. It is noted

that the threads 4 and 6 are of opposite hand, and that a tool operator need be careful that the direction of rotation of the boss 1 not tend to loosen the hole saw during operation, but the operator could simply use a hole saw having a desired direction of rotation that wouldn't cause unthreading to happen, and claim 16 is so broadly written that there simply isn't enough there to preclude applying Webster against it. Regarding claim 19, it is considered to be inherent to provide appropriately sized thread diameters. Webster is capable of performing the function of claim 20. The taper/connection means 1 will engage an appropriate mandrel/spindle. Webster does not explicitly show a notch. Mori shows a similar taper shank 10, and as seen from figure 2 the flange has a notch that receives the usual drive key on the spindle. It is considered to have been obvious to have provided Webster with such a notch for reception of a drive key in order to transfer torque from the spindle to the taper shank without slippage.

2. Claims 16-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Makar (4303357) in view of Anderson (5624213). As best seen from figure 1, Makar shows a hole saw 29a having a rear wall with a circular opening 31a, 32a, having flats 33a, 34a. To connect the hole saw to a boss/base member 16, the flats 33a, 34a, are aligned with flats 20a, 21a, and then the hole saw is slightly turned to form a bayonet connection with the base/boss. Note pilot drill 15 secured by screw 12. Connection means 10 is located in an appropriate holder/mandrel. As discussed at column 1, lines 12-19, and 52-55, and column 3, lines 60 through column 4, line 36, the boss/base is provided with two such bayonet connecting devices 17, 17a, such that hole saws having different sizes of connections can be used on the same boss/base. Other types of connections between the hole saw and boss/base are well known. Figure 1 of Anderson shows a boss/base 28 having a threaded portion 46 for holding hole saws 12. As seen from figures 3 and

5, the threads may be long enough to support two hole saws on one set of threads 46. It is considered to have been obvious to have provided Makar with threads as shown by Anderson on the larger and smaller connecting devices 17, 17a, in order to be able to hold threaded hole saws of different sizes, as this is a simple substitution of one known element/connection for another in order to obtain a predictable result of securing the hole saw on the boss/base. Claim 16 has been amended to set forth a notch on the base member. Figure 1 of Makar shows a flat on the shank 10, but no explicit detail about this flat is given. Figures 1 and 2 of Anderson shows a similar shank in which this flat is provided as a notch 40. Note from figures 1 and 2 that the shank 38 was originally cylindrical, and the notches 40 were cut into the shank in order to aid in placement in a chuck. See column 3, lines 1-10. It is considered to have been obvious to have provided the base of Makar with a notch as shown by Anderson in order to aid in locating the shank in a chuck.

3. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makar in view of Anderson as applied to claims 16 and 17 above, and further in view of Burk (6676343). It is well known to use device such as Makar for enlarging holes. Figure 2 shows a smaller diameter hole saw 40 extending axially forward of larger diameter hole saw 30, such that the smaller diameter hole saw will serve as a pilot in the hole 101. It is considered to have been obvious to have equipped Makar with two hole saws as shown by Burk in order to enlarge a previously existing hole.

4. Claims 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over French 2587245 in view of Bossler (4551045). As best seen from figure 1, FR '245 shows several hole saws 2 of different diameters and having a rear wall with projections 2a. To connect a hole saw

to a boss/base member 1, the projections 2a are aligned with mating grooves at 1d, and then the hole saw is slightly turned to form a bayonet connection with the base/boss 1. As seen from figure 2, the annular groove adjacent the lead line for numeral 1 constitutes a "notch." Note the central hole for a pilot drill. The shank near numeral 1 is a connection means 10 for location in an appropriate holder/mandrel. Other types of connections between the hole saw and boss/base are well known. Figure 2 of Bossler shows a boss/base having a threaded portion 26 for holding larger diameter annular cutter 21, and a second set of smaller diameter threads on member 25 to secure a smaller diameter annular cutter 20. Note that the cutter 20 extends well forward of cutter 21, and the smaller diameter may also be used as a pilot in a pre-existing hole. It is considered to have been obvious to have provided French '245 with threads as shown by Bossler on the various diameter steps 1b in order to be able to hold threaded hole saws of different sizes, as this is a simple substitution of one known element/connection for another in order to obtain a predictable result of securing the hole saw on the boss/base.

5. Claims 26 and 27 are allowed.

6. Applicant's arguments filed 10-16-09 have been fully considered but they are not persuasive. Regarding the new limitation to claim 16, this feature has been treated in the rejection above. While the Mori reference was added to the rejection with Webster to show the "notch," it is noted that the other references applied previously also had structure that constitutes a "notch." Applicant's arguments are basically "form paragraphs" that don't address the specific features of the rejections. It is noted that Applicant has copied pasted the argument for Webster into the arguments for Cantlon and Leary without even changing the name from "Webster" to the different reference. At any rate, the "notch" feature of claim 16 has been treated above.

Similarly, Applicant's response to Makar in view of Anderson, Makar in view of Anderson and Burk, and French '245 in view of Bossler consist entirely of "form paragraph" responses not addressing the specifics of the rejection in any way whatsoever. Applicant's "form paragraphs" make three arguments: 1) there is no justification to combine the references; 2) the proposed combination would not show all of the features of claim 16; and 3) the features of claim 16 provide new and unexpected results. In response to Applicant's Point 1, it is noted that **1) each of the rejections made above provides justification for combining the references; 2) each of the combinations shows all of the claimed features; and 3) Applicant has made no effort whatsoever to point out what any "new and unexpected results" are present in this instant situation. Pages 10 through 15 of Applicant's response do not point to the rejection in any way to argue why the rejections are not proper.** Page 11 of the response makes the blanket statement that the Examiner has not given any acceptable reason to support the combination. **Yes, the examiner did. It is clearly in the rejection.** Applicant has made no effort to tie the "form paragraph" of pages 12-15 of the response into the fact pattern of this application. The Office action above sets forth proper rejections meeting the standard of *Graham vs Deere*. If Applicant disagrees with why the rejections in this Office action were made, then Applicant needs to at least state reasons why the rationale set forth in the rejection is not proper. Submitting pages of "form paragraph" arguments without placing them in the context of the rejection made does nothing to provide reasons why the rejections are not proper.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, David Bryant, may be reached at 571-272-4526.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3726 at the top of your cover sheet.

/Daniel W. Howell/

Primary Examiner, Art Unit 3726